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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,228	09/25/2006	Patrice Henri Lointier	80350-1230	7480
24504 7590 03/10/2010 THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 600 GALLERIA PARKWAY, S.E. STE 1500 ATLANTA, GA 30339-5994				
EXAMINER				
GRAHAM, BRIAN J				
ART UNIT		PAPER NUMBER		
3734				
MAIL DATE		DELIVERY MODE		
03/10/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/500,228

**Applicant(s)**

LOINTIER ET AL.

**Examiner**

BRIAN GRAHAM

**Art Unit**

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 06/25/2004

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group IV in the reply filed on January 19, 2010 is acknowledged. The traversal is on the ground(s) that the restriction requirement between apparatus and method claims places an unfair burden on the Applicant, and that the inventions of groups I, II, III, and IV are similar in subject matter and do not place a serious burden on the Examiner. This is not found persuasive because the apparatus and method groups each contain distinct special technical features, such as two concentric balloons in an apparatus group and a method of inverting a balloon, which, as per PCT Rule 13.2, renders them properly restrictable. Furthermore, the difference in scope of Groups I, II, III, and IV does in fact place a serious search and examination burden on the examiner, because all four groups contain unique features and components, with little to no overlap between groups, aside from the fact that all groups pertain to an intragastric balloon.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on January 19, 2010.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gau *et al.*, hereinafter referenced as "Gau" (United States Patent Number 5,084,061) in view of Smith (United States Patent Number 3,238,107).

Gau discloses an intra-gastric balloon (20) for treating obesity, for implanting in the stomach of a patient to reduce the volume of the stomach, said balloon comprising a flexible envelope (22) defining a predetermined inside volume, said flexible envelope being made of an elastomer material (col. 4, lines 6-12). While Gau fails to disclose a particular dimensional tolerance of the nominal thickness of the envelope of the balloon, Smith discloses a method of producing silicone elastomers which results in "extremely close dimensional tolerance" (col. 19, lines 13-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the silicone elastomer envelope of Gau by the method of Smith in order to provide the envelope with uniform density, excellent physical properties, and the extremely close dimensional tolerance recited by Smith. Furthermore, where Gau and Smith disclose the claimed invention except for the dimensional tolerance being in the range of 1-20% or 10-16%, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize such ranges, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding claim 27, Gau and Smith disclose the claimed invention except for the thickness of the envelope is recited as being on the order of 0.075 inches or less (col. 19, lines

34-39), as opposed to being substantially 0.5 mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize such a thickness, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 29, Smith discloses forming the elastomer using a mold (col. 19, lines 40-45).

Regarding claim 30, the claimed method steps are being treated as product by process limitations; that is the patentability of the claim is based on the product itself. As set forth in MPEP 2113, product by process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 USC 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. MPEP 2113.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN GRAHAM whose telephone number is (571)270-7484. The examiner can normally be reached on Monday - Friday 8:00 am-5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571)272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B.J.G./  
March 2, 2010

/Todd E Manahan/  
Supervisory Patent Examiner, Art Unit 3734